

REMARKS

This is in response to the Office Action dated November 02, 2006 and the telephonic interview between the Examiner and Applicant's counsel, Eric L. Tanezaki, on March 5, 2007. As a result of such telephonic interview, it was agreed that additional briefing from Applicant would be helpful on the issue of the rejection of Claims 1-7 under 35 U.S.C. §101 as being indefinite and under 35 U.S.C. §112 as overlapping of two statutory classes on invention. (Office Action, page 5-6, paragraphs 8-11). Citation is made to Ex Parte Lyell (17 U.S.P.Q.2d 1548).

Applicant agrees with the proposition that a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. §112. Moreover, such a claim would be directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. §101 which is drafted to set forth the statutory classes in the alternative only. (See M.P.E.P. 2173.05(p)II) which also cites to the Ex Parte Lyell case. However, the facts of the present matter are fundamentally different than those contemplated in the M.P.E.P. 2173.05(p)II and Ex Parte Lyell case, and the rejections under 35 U.S.C. §§101 and 112 are inappropriate.

In the Ex Parte Lyell case, at issue was the following claim:

2. *An automatic transmission tool in the form of a workstand and method for using same comprising:*
a support means;
and [sic] internally splined sleeve affixed upright to said support means,
a threaded adjustment bolt threadably engaged through a hole in the bottom of said support means and projecting upward through said support frame into said sleeve;
and further comprising the steps of
 - 1. positioning the output end of an automatic transmission onto said upright sleeve,*
 - 2. removing the internal components of said automatic transmission from the casing of said transmission,*
 - 3. repairing and replacing said internal components back into said casing, and*
 - 4. adjusting said internal components for fit and interference by means of adjusting said upwardly projecting adjustment bolt.*

In reviewing this Claim 2, the Federal Circuit quoted the prior discussion in Ex Parte Forsyth, 151 U.S.P.Q. 55, 56 (Bd. Of Appeals 1965) as follows:

"A claim such as those before us cannot be both method and apparatus. It must be clear from its wording that it is drawn to one or the other of these mutually exclusive statutory classes of invention. A method or process, as indicated above, is an act or series of acts and from the standpoint of patentability must distinguish over the prior art in terms of steps, whereas a claim drawn to apparatus must distinguish in terms of structure."

In the Ex Parte Lyell case, the subject Claim 2 indeed had in its preamble identification of the claim being drawn to both an apparatus and a method (i.e., "*a workstand and method for using same*"). Further, in the body of the claim were both structural elements (namely, the three listed elements of "*a support means,*" "*an internally splined sleeve,*" and "*a threaded adjustment bolt*") and method steps (namely, the four itemized steps of "*positioning,*" "*removing,*" "*repairing,*" and "*adjusting*").

In contrast, the preamble of the present Claim 1 clearly indicates the nature of the claim as being directed towards a method (namely an "automated method of communicating trade orders"). Furthermore, the body of the present Claim 1 recites only method steps. Each element of Claim 1 is a step or act, namely the acts of "*receiving,*" "*accessing,*" and "*communicating.*" Applicant respectfully contends that Claim 1 is indeed directed solely to a method.

In the Office Action, the Examiner argues that it cannot be determined whether Claim 1 "is a method claims a system claim because the claim has a combination of method steps and system elements." (Office Action, page 5, paragraph 9).

It is recognized that each given method step may include utilization of structure or hardware. For example, the first method step of "*receiving*" contemplates utilization of "*market analysis software,*" and dependent Claim 3 requires the method step of "*receiving*" is effectuated through the utilization of a "*computer network.*" Nonetheless, this does not change the fundamental character of Claim 1 as being a method claim.

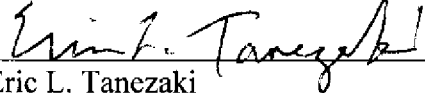
By way of analogy, a method of gardening that has a step of digging a hole with a shovel would not be considered to be overlapping two statutory classes just because a structure of a shovel is required.

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Accordingly, Applicant respectfully requests reconsideration as to the applicability of the rejections under 35 U.S.C. §§101 and 112. If any additional fee is required, please charge Deposit Account Number 19-4330.

Respectfully submitted,

Date: 3 / 7 / 7

By: 

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